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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,292	02/12/2004	Scott Elliott	723-1472	3521

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EXAMINER

ONEILL, MICHAEL W

ART UNIT PAPER NUMBER

3713

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/776,292	Applicant(s) ELIOTT, SCOTT	
	Examiner Michael O'Neill	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 9, 12-27 and 36-48 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 8, 10, 11 and 28-35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

#### ***Priority***

Applicant is reminded of the Applicant's responsible to update the priority data in the first line of the specification.

#### ***Serial numbers within Specification***

Applicant is reminded to update the status of all application incorporated by reference within the instant specification, see e.g. para [0006] and [0008].

#### ***Specification***

The disclosure is objected to because of the following informalities: there are non-alphanumerical symbols throughout the instant specification that appear to have no apparent meaning and need to be removed or explained, see e.g. pages 13, 24 and 27.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25-48 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a

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video game console or a home video game system, does not reasonably provide enablement for an information processing apparatus. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Throughout the entire prosecution of the lineage of the parent applications to this child application, the Applicants have feverishly argue to the Examiner that the invention is directed to a video game console or home video game system and not a personal computer, see the prosecution history of S/N 09/288,293 and 09/384,189.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 30 and those that depend therefrom are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"Said digital processor" lacks antecedent basis. The Examiner will assume this claim is suppose to depend from claim

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28 and not claim 25 and has examined the claims accordingly with respect to the prior art.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25, 27 and 36-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasche et al. '824.

In figures 3, 13 and 14 and col. 5 and col. 10, Hasche discloses a mass storage medium (11). This medium (11) is used to storing application programs authorized by the vendor for the user to use. The medium (11), see figures 3, 13 and 14 as associated with it a medium number stored thereon and this medium number equals to an associated ID code as claimed by the Applicant. This number is in an unwriteable location on the medium (11). Hasche et al. also discloses a permission information (13) which is provided by the vendor to the user to permit use of the software; this is part of the mass media controller. The vendor computer, see figure 2, the server, includes the personal key generating unit (21), the software

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decrypting key (24) and the encrypting unit (23). The person key generating unit (21) generates the medium key base on the medium number (12) sent to it from the mass storage medium (11), see figures 7A and 7B. The encrypting unit (23) encrypts the software decrypting key (24) base on the medium key generated by the personal key generating unit (21). The data encrypted by the encrypting unit (23) is stored in the mass storage unit (11) as the permission information. The user computer, the information processing apparatus, see figures 3, 13 and 14, includes a personal key generating unit (31), the decrypting unit (32), the software decrypting key (35), and the decrypting unit (34). The personal key generating unit (31) generates the medium key based on the medium number (12) read from the software storage medium (11), see figures 7A and 7B. The decrypting unit (32) decrypts the permission information (13) read from the software storage medium (11) based on the medium key generated by the personal key generating unit (31), and generates the software decrypting key (35), see figures 9A and 9B. The decrypting unit (34) decrypts the encrypted software (15) read from the software storage medium (11) based on the software decrypting key (35) and generates the application program, see figures 9A and 9B. Then the user's computer

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executes the application program which was stored on the mass storage medium (11).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 6, 7, 9 and 12-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasche et al. '824.

What Hasche et al. discloses, teaches and suggests to one skilled in the art is discussed above and incorporated herein. What it lacks in clearly disclosing is the application

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programs being video games. Instead, the reference talks about application programs in general calling it either software, electronic data, plain text software, electronically published data. Video games are considered by the those skilled in the art as a subset of electronically published data or software or application programs. Therefore, one skilled in the art would find it obvious to use the invention of Haste et al. for the video game art.

#### ***Allowable Subject Matter***

Claims 4, 5, 8, 10, 11, 28, 29, 34 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 30-33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 703-308-3484. The examiner



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can normally be reached on Monday through Friday 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 703-308-2064. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**MICHAEL O'NEILL**  
**PRIMARY EXAMINER**